

ESTTA Tracking number: **ESTTA770362**

Filing date: **09/13/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Ministry of Sound Group Limited
Granted to Date of previous extension	09/14/2016
Address	103 Gaunt Street London, SE 16DP UNITED KINGDOM

Correspondence information	Jenevieve Maerker Attorney Foley Hoag LLP 155 Seaport Blvd. Boston, MA 02210 UNITED STATES jmaerker@foleyhoag.com, jjarvis@foleyhoag.com, ustrademark@foleyhoag.com, lcasey@foleyhoag.com Phone:617-832-1000
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Applicant Information

Application No	86765252	Publication date	05/17/2016
Opposition Filing Date	09/13/2016	Opposition Period Ends	09/14/2016
Applicant	Kretek International 5449 Endeavour Court Moorpark, CA 93021 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cigars and Cigarillos
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2754753	Application Date	08/04/1999
Registration Date	08/26/2003	Foreign Priority Date	NONE

Word Mark	HED KANDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 [AMPLIFIERS, ANSWERING MACHINES; CAMCORDERS; CAMERAS; CASSETTE PLAYERS; CASSETTE RECORDERS; TAPE PLAYERS; TAPE RECORDERS; VIDEO TAPE PLAYERS AND VIDEO RECORDERS; DIGITAL TAPE PLAYERS AND DIGITAL TAPE RECORDERS; OPTICAL DISK PLAYERS; OPTICAL DISK RECORDERS; TELEPHONES; LOUD SPEAKERS; MICROPHONES; MODEMS; COMPUTER MONITORS; MOVIE PROJECTORS; PROJECTION SCREENS; RADIOS; AUDIO AND VIDEO SIGNAL RECEIVERS; SLIDE PROJECTORS; DISC RECORDERS; RECORD PLAYERS, DISC PLAYERS; TELEVISIONS; PRE-RECORDED RECORDS AND TAPES CONTAINING MUSIC, MOTION PICTURES AND TELEVISION PROGRAMS;] AUDIO, VIDEO AND COMPACT DISCS FEATURING MUSIC [, MOTION PICTURES AND TELEVISION PROGRAMS; COMPUTER SOFTWARE AND FIRMWARE RELATING TO THE TRANSMISSION AND BROADCAST OF MUSIC AND SPEECH AND FOR THE ACQUIRING OF AND DOWNLOADING OF MUSIC AND SPEECH VIA A GLOBAL COMPUTER NETWORK; COMPUTER HARDWARE]</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 [BOOKS, MAGAZINES, PERIODICALS, ANNUALS ALL RELATING TO MUSIC, STATIONERY; PICTURES,] POSTERS AND PHOTOGRAPHS [; GREETING CARDS]</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 [PRODUCTION OF RADIO AND TELEVISION PROGRAMS; CONCERT BOOKINGS;] ENTERTAINMENT, namely, LIVE MUSIC CONCERTS; ORGANIZATION OF MUSICAL FESTIVALS</p>		
U.S. Registration No.	3999159	Application Date	09/27/2007
Registration Date	07/19/2011	Foreign Priority Date	NONE
Word Mark	HED KANDI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2001/12/00 First Use In Commerce: 2001/12/00 Nightclubs, resort services in the nature of beach clubs, namely, nightclubs by the beach; entertainment services in the nature of discotheques, dance club services featuring live and pre-recorded music, videos and dancing, live concerts featuring music, and television and radioprograms featuring music, video and live action; provision of nondownloadable online digital music from the Internet

U.S. Registration No.	4820381	Application Date	02/01/2012
Registration Date	09/29/2015	Foreign Priority Date	NONE
Word Mark	HED KANDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely jackets, shirts, tee shirts, shorts, tracksuits, skirts, scarves, dresses, trousers, sweatshirts, track pants, vests, blouses; footwear, namely shoes, slippers and sandals; headgear, namely hats and caps Class 043. First use: First Use: 0 First Use In Commerce: 0 Bars, restaurants and hotels; provision of temporary accommodation services and catering services; making reservations and bookings for restaurants and temporary vacation lodging; services for providing food and drink		

Attachments	75767362#TMSN.png(bytes) 77981804#TMSN.png(bytes) 85530568#TMSN.png(bytes) Notice of Opposition HED KANDI.pdf(326369 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jenevieve Maerker/
Name	Jenevieve Maerker
Date	09/13/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ministry of Sound Group Limited,

Opposer,

v.

Kretek International,

Applicant.

Opposition No. _____

Trademark: HED KANDI

Application S.N. 86/765,252

NOTICE OF OPPOSITION

Ministry of Sound Group Limited, a United Kingdom limited company, having its place of business at 103 Gaunt Street, London, United Kingdom SE 16DP (“Opposer”) believes that it is and/or will be damaged by registration on the Principal Register of the mark HED KANDI, which is the subject of Application Serial No. 86/765,252 filed by Kretek International (“Applicant”).

The grounds for this opposition are as follows:

1. Opposer is a well-known multimedia entertainment company providing music, radio, night clubs, festivals, and other music- and entertainment-based goods and services around the world.
2. Opposer adopted and has used the trademark HED KANDI in commerce and worldwide in connection with its music- and entertainment-related goods and services, and has built the globally recognized HED KANDI healthy lifestyle brand around those goods and services.
3. The HED KANDI mark is distinctive.

4. As a result of Opposer's widespread use and advertising, Opposer's HED KANDI trademark is famous worldwide and widely associated with Opposer's goods and services and Opposer's healthy lifestyle image, and has acquired significant and valuable goodwill.

5. Opposer is the owner of the following valid United States Principal Register trademark registrations for HED KANDI:

Mark	Registration No.	Goods and Services
HED KANDI	2,754,753	Class 9: audio, video and compact discs featuring music. Class 16: posters and photographs. Class 41: entertainment, namely, live music concerts; organization of musical festivals
HED KANDI	3,999,159	Class 41: Nightclubs, resort services in the nature of beach clubs, namely, nightclubs by the beach; entertainment services in the nature of discotheques, dance club services featuring live and pre-recorded music, videos and dancing, live concerts featuring music, and television and radio programs featuring music, video and live action; provision of nondownloadable online digital music from the Internet.
HED KANDI	4,820,381	Class 25: Clothing, namely jackets, shirts, tee shirts, shorts, tracksuits, skirts, scarves, dresses, trousers, sweatshirts, track pants, vests, blouses; footwear, namely shoes, slippers and sandals; headgear, namely hats and caps. Class 43: Bars, restaurants and hotels; provision of temporary accommodation services and catering services; making reservations and bookings for restaurants and temporary vacation lodging; services for providing food and drink.

6. Printouts of the U.S. Patent and Trademark Office's TESS and Assignment databases in connection with the above-referenced registrations are attached hereto as Exhibit A,

pursuant to Trademark Rule 2.122(d), 37 CFR § 2.122(d), and the registrations are placed into evidence.

7. Upon information and belief, Applicant is an importer, marketer, and distributor of tobacco products.

8. On September 23, 2015, Applicant filed the subject application, Application Serial No. 86/765,252, to register HED KANDI in connection with “cigars and cigarillos” in Class 34.

9. The Application was filed on a Section 1(b) basis and, on information and belief, any use in commerce by Applicant of HED KANDI commenced after Opposer’s use of HED KANDI began and after Opposer’s HED KANDI mark became famous.

10. Opposer’s HED KANDI mark and the mark subject to Applicant’s Application Serial No. 86/765,252 (HED KANDI) are identical.

11. Because Opposer’s famous HED KANDI mark is subject to a wide scope of protection, the applied-for mark, HED KANDI, is likely to cause confusion, mistake, or deception as to the source of Applicant’s goods, to Opposer’s damage and detriment. Furthermore, customers or potential customers are likely to believe that Applicant’s goods are sponsored by, approved by, or affiliated with Opposer when that is not the case. Any dissatisfaction with Applicant’s goods is likely to reflect upon and damage the goodwill and reputation embodied in Opposer’s mark, HED KANDI.

12. The applied-for mark, HED KANDI, is likely to cause dilution by blurring and dilution by tarnishment of Opposer’s famous HED KANDI mark. It is likely to cause dilution by blurring because the applied-for identical mark could weaken or damage Ministry of Sound’s HED KANDI mark, such that consumers will no longer associate the mark exclusively with

Ministry of Sound. It is likely to cause dilution by tarnishment to our client's HED KANDI brand because of the applied-for mark's association with cigars and cigarillos, products that are widely considered to be unhealthy and addictive, which is contrary to the fitness and healthy lifestyle focus of Opposer's HED KANDI goods and services.

WHEREFORE, Opposer requests that registration of the applied-for mark, HED KANDI, Application Serial No. 86/765,252, be denied, and that this opposition be sustained.

Respectfully submitted,

Ministry of Sound Group Limited

Dated: September 13, 2016

/Jenevieve Maerker/

Joshua Jarvis

Jenevieve Maerker

Foley Hoag LLP

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Boston, MA 02210

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Notice of Opposition, with exhibit, was served via First Class Mail and email upon Applicant's Attorney of Record on September 13, 2016, as follows:

Shauna Maloney
Raj Abhyanker P.C.
451 N. Shoreline Blvd.
Mountain View, CA 94043-4605
trademarks@legalforce.com

/Jenevieve Maerker/
Jenevieve Maerker

EXHIBIT A



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HED KANDI

Word Mark HED KANDI

Goods and Services IC 009. US 021 023 026 036 038. G & S: [AMPLIFIERS, ANSWERING MACHINES; CAMCORDERS; CAMERAS; CASSETTE PLAYERS; CASSETTE RECORDERS; TAPE PLAYERS; TAPE RECORDERS; VIDEO TAPE PLAYERS AND VIDEO RECORDERS; DIGITAL TAPE PLAYERS AND DIGITAL TAPE RECORDERS; OPTICAL DISK PLAYERS; OPTICAL DISK RECORDERS; TELEPHONES; LOUD SPEAKERS; MICROPHONES; MODEMS; COMPUTER MONITORS; MOVIE PROJECTORS; PROJECTION SCREENS; RADIOS; AUDIO AND VIDEO SIGNAL RECEIVERS; SLIDE PROJECTORS; DISC RECORDERS; RECORD PLAYERS, DISC PLAYERS; TELEVISIONS; PRE-RECORDED RECORDS AND TAPES CONTAINING MUSIC, MOTION PICTURES AND TELEVISION PROGRAMS;] AUDIO, VIDEO AND COMPACT DISCS FEATURING MUSIC [, MOTION PICTURES AND TELEVISION PROGRAMS; COMPUTER SOFTWARE AND FIRMWARE RELATING TO THE TRANSMISSION AND BROADCAST OF MUSIC AND SPEECH AND FOR THE ACQUIRING OF AND DOWNLOADING OF MUSIC AND SPEECH VIA A GLOBAL COMPUTER NETWORK; COMPUTER HARDWARE]

IC 016. US 002 005 022 023 029 037 038 050. G & S: [BOOKS, MAGAZINES, PERIODICALS, ANNUALS ALL RELATING TO MUSIC, STATIONERY; PICTURES,] POSTERS AND PHOTOGRAPHS [; GREETING CARDS]

IC 041. US 100 101 107. G & S: [PRODUCTION OF RADIO AND TELEVISION PROGRAMS; CONCERT BOOKINGS;] ENTERTAINMENT, namely, LIVE MUSIC CONCERTS; ORGANIZATION OF MUSICAL FESTIVALS

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75767362

Filing Date August 4, 1999

Current Basis 44E

Original Filing Basis 1B

Published for June 3, 2003

Opposition**Registration
Number** 2754753**Registration
Date** August 26, 2003**Owner** (REGISTRANT) Golden Rose Communications Plc LIMITED LIABILITY COMPANY UNITED KINGDOM 26-27
Castlereagh Street London, WIH 6DJ UNITED KINGDOM(LAST LISTED OWNER) MINISTRY OF SOUND GROUP LIMITED LIMITED COMPANY UNITED KINGDOM
103 GAUNT STREET LONDON UNITED KINGDOM SE16DP**Assignment
Recorded** ASSIGNMENT RECORDED**Attorney of
Record** Joshua Jarvis, Esq.**Type of
Mark** TRADEMARK. SERVICE MARK**Register** PRINCIPAL**Affidavit
Text** SECT 8 (6-YR). SECTION 8(10-YR) 20130824.**Renewal** 1ST RENEWAL 20130824**Live/Dead
Indicator** LIVE[TESS HOME](#)[NEW USER](#)[STRUCTURED](#)[FREE FORM](#)[BROWSE DICT](#)[SEARCH OG](#)[TOP](#)[HELP](#)[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



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164 DEANS GATE

MANCHESTER, LANCASHIRE, UNITED KINGDOM M3 3GG

Correspondent: ANDREW H. SIMPSON

2040 MAIN STREET

14TH FLOOR

IRVINE, CA 92614

Domestic rep: ANDREW H. SIMPSON

2040 MAIN STREET

14TH FLOOR

IRVINE, CA 92614

Assignment: 2**Reel/Frame:** [3257/0853](#)**Recorded:** 03/02/2006**Pages:** 3**Conveyance:** CHANGE OF NAME**Assignor:** [JAZZ FM PLC.](#)**Exec Dt:** 03/26/2003**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** UNITED KINGDOM**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** UNITED KINGDOM**Assignee:** [JAZZ FM LIMITED](#)

164 DEANS GATE

MANCHESTER, LANCASHIRE, UNITED KINGDOM M3 3GG

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IRVINE, CA 92614

Domestic rep: ANDREW H. SIMPSON

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IRVINE, CA 92614

Assignment: 3**Reel/Frame:** [3258/0524](#)**Recorded:** 03/03/2006**Pages:** 6**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** [JAZZ FM LIMITED](#)**Exec Dt:** 10/05/2005**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** UNITED KINGDOM**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** UNITED KINGDOM**Assignee:** [GMG RADIO HOLDINGS LIMITED](#)

164 DEANS GATE

MANCHESTER, LANCASHIRE, UNITED KINGDOM M3 3GG

Correspondent: ANDREW H. SIMPSON

2040 MAIN STREET

14TH FLOOR
IRVINE, CA 92614

Domestic rep: ANDREW H. SIMPSON
2040 MAIN STREET
14TH FLOOR
IRVINE, CA 92614

Assignment: 4**Reel/Frame:** [3296/0039](#)**Recorded:** 04/25/2006**Pages:** 7**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** [GMG RADIO HOLDINGS LIMITED](#)**Assignee:** [MINISTRY OF SOUND HOLDINGS LIMITED](#)

103 GAUNT STREET
LONDON, UNITED KINGDOM SE1 6DP

Correspondent: TRACY ZAWASKI - RADER, FISHMAN & GRAUER
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304

Exec Dt: 01/26/2006**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** UNITED KINGDOM**Entity Type:** PRIVATE LIMITED COMPANY**Citizenship:** UNITED KINGDOM**Assignment: 5****Reel/Frame:** [3904/0996](#)**Recorded:** 12/16/2008**Pages:** 4**Conveyance:** CHANGE OF NAME**Assignor:** [MINISTRY OF SOUND HOLDINGS LTD.](#)**Assignee:** [MSHK LIMITED](#)

103 GAUNT STREET
LONDON, UNITED KINGDOM SE16DP

Correspondent: HAL BORDEN
DECHERT LLP
CIRA CENTRE, 2929 ARCH STREET
PHILADELPHIA, PA 19104-2808

Exec Dt: 07/21/2008**Entity Type:** LIMITED COMPANY**Citizenship:** UNITED KINGDOM**Entity Type:** LIMITED COMPANY**Citizenship:** UNITED KINGDOM

Domestic rep: HAL BORDEN
DECHERT LLP
CIRA CENTRE, 2929 ARCH STREET
PHILADELPHIA, PA 19104-2808

Assignment: 6**Reel/Frame:** [4280/0341](#)**Recorded:** 09/17/2010**Pages:** 3**Conveyance:** CHANGE OF NAME**Assignor:** [MSHK LIMITED](#)**Assignee:** [MINISTRY OF SOUND GROUP LIMITED](#)

103 GAUNT STREET
LONDON, UNITED KINGDOM SE16DP

Correspondent: GLENN A. GUNDERSEN
DECHERT LLP
CIRA CENTRE, 2929 ARCH STREET
PHILADELPHIA, PA 19104-2808

Exec Dt: 01/28/2010**Entity Type:** LIMITED COMPANY**Citizenship:** UNITED KINGDOM**Entity Type:** LIMITED COMPANY**Citizenship:** UNITED KINGDOM

Domestic rep: GLENN A. GUNDERSEN
DECHERT LLP
CIRA CENTRE, 2929 ARCH STREET
PHILADELPHIA, PA 19104-2808



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HED KANDI

Word Mark HED KANDI

Goods and Services IC 041. US 100 101 107. G & S: Nightclubs, resort services in the nature of beach clubs, namely, nightclubs by the beach; entertainment services in the nature of discotheques, dance club services featuring live and pre-recorded music, videos and dancing, live concerts featuring music, and television and radio programs featuring music, video and live action; provision of nondownloadable online digital music from the Internet. FIRST USE: 20011200. FIRST USE IN COMMERCE: 20011200

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77981804

Filing Date September 27, 2007

Current Basis 1A

Original Filing Basis 1B

Published for Opposition January 13, 2009

Registration Number 3999159

Registration Date July 19, 2011

Owner (REGISTRANT) MINISTRY OF SOUND GROUP LIMITED LIMITED COMPANY UNITED KINGDOM 103 GAUNT STREET LONDON UNITED KINGDOM SE16DP

Assignment Recorded ASSIGNMENT RECORDED

Attorney of

Record Joshua Jarvis, Esq.

Prior Registrations 2754753

Type of Mark SERVICE MARK

Register PRINCIPAL

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For Serial Number: 77981804

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HED KANDI

Word Mark HED KANDI

Goods and Services IC 025. US 022 039. G & S: Clothing, namely jackets, shirts, tee shirts, shorts, tracksuits, skirts, scarves, dresses, trousers, sweatshirts, track pants, vests, blouses; footwear, namely shoes, slippers and sandals; headgear, namely hats and caps

IC 043. US 100 101. G & S: Bars, restaurants and hotels; provision of temporary accommodation services and catering services; making reservations and bookings for restaurants and temporary vacation lodging; services for providing food and drink

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85530568

Filing Date February 1, 2012

Current Basis 44E

Original Filing Basis 1B;44E

Published for Opposition June 26, 2012

Registration Number 4820381

Registration Date September 29, 2015

Owner (REGISTRANT) Ministry of Sound Group Limited limited company (Ltd.) UNITED KINGDOM 103 Gaunt Street London UNITED KINGDOM SE16DP

Attorney of Joshua Jarvis, Esq.

Record**Type of Mark** TRADEMARK. SERVICE MARK**Register** PRINCIPAL**Live/Dead
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